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| 10/542,212      | 07/14/2005  | Dieter Gansert       | SUS-108/500711.20008 | 1749             |

26418 7590 12/09/2009  
REED SMITH, LLP  
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599 LEXINGTON AVENUE, 29TH FLOOR  
NEW YORK, NY 10022-7650

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| EXAMINER |
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SCHATZ, CHRISTOPHER T

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| ART UNIT | PAPER NUMBER |
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1791

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12/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                       |  |  |
|------------------------------|---------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/542,212  | <b>Applicant(s)</b><br>GANSERT, DIETER |  |
|                              | <b>Examiner</b><br>CHRISTOPHER SCHATZ | <b>Art Unit</b><br>1791                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-50 is/are pending in the application.
- 4a) Of the above claim(s) 26-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

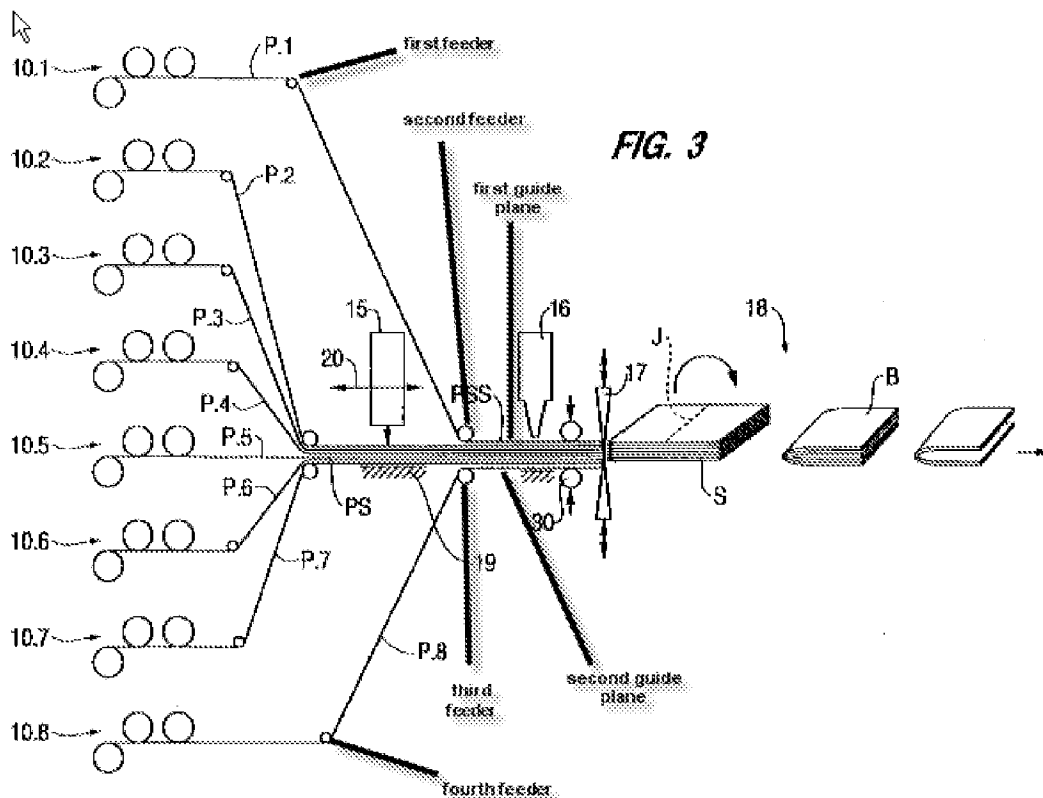
**FINAL REJECTION**

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honegger (US 5961758, previously cited) in view of Neubauer et al. (US 6656103, newly cited).

Honegger discloses a device capable of producing a brochure comprising at least one sheet feed (any of P.1-P.8); a joining means supply device for applying joining means 15; two guide planes, including a first guide plane and second guide plane lying one above the other at a distance from one another being provided in the vicinity of where the folding occurs for separate placement of a contents sheet and a cover sheet in the first guide plane and the second guide plane.

The applicant is referred to figure 3 below:



While Honegger clearly discloses that folding occurs, it is unclear if Honegger discloses a folding device wherein said folding device is capable of passing through the guide planes. Neubauer discloses an apparatus of folding sheets to be used in a booklet, where said apparatus comprises using a folding device 416, said folding device capable of moving toward said sheet such that a fold is produced at the location where the device contacts the sheets (figures 13A, 13B, column 13, line 47 – column 14, line 8). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the apparatus of Honegger by adding a folding device capable of passing through the guide planes in order to fold the sheets as taught by Neubauer above as such a folding device is a known folding means and enables the apparatus of

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Honegger to produce a high quality fold. When the folding device 416 of Neubauer is added to the apparatus of Honegger, said device must be capable of passing through the guide planes in order to fold the sheets of Honegger. Said folding device is capable of functioning as a joining device.

As to claims 42-45, the first guide plane for a contents sheet cooperates with the second feeder and is capable of supplying the contents sheet to the first guide plane in immediate succession. The second feeder is at the first guide plane and adjacent to the first guide plane and the first guide plane is above the second guide plane. The third feeder cooperates with the second guide plane and is capable of supplying the latter with a cover sheet in immediate succession. The third feeder is at the second guide plane. Both feeders are adjacent to the folding device.

As to claim 46, the first feeder reads on a feeder for a contents sheet and the fourth feeder reads on a feeder for a cover sheet. Each of these feeders are arranged on the opposite sides of the guide planes, the first feeder conveys a contents sheet in a direction (down towards the first guide plane) opposite to the direction in which the fourth roller conveys a cover sheet (up towards the second guide plane).

***Claim Rejections - 35 USC § 103***

3. Claims 41, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerhard et al. (US 6363851, newly cited), Flora (US 3216719, newly cited) and Neubauer et al.

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Gerhard discloses a device capable of producing a brochure comprising at least one sheet feed (column 2, lines 60-67); a joining means supply device for applying joining means (column 3, lines 55-57; adhesive bonding). Gerhard discloses that the sheets are joined and folded (column 3, lines 1-12). While the step of feeding sheets upon one another necessarily requires the presence of a guide plane, Gerhard is silent as to the presence of two guide planes, one above the other. Flora discloses an apparatus capable of making a brochure, said apparatus comprising at least two guide planes, wherein at least one guide plane is above and spaced from another guide plane. The guide planes of Flora are defined by platform 64 of each magazine. Each platform of each magazine is capable of placing a sheet that can function as a contents sheet and a sheet that can function as a cover sheet. The platforms can move vertically up and down so that a first platform (first guide plane) for placing a contents sheet will be above a second platform (second guide plane) for placing a cover sheet in order for the contents sheet to be placed at a proper height (column 3, lines 22-32; figures 2 and 3). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the apparatus of Gerhard such that said apparatus has a first guide plane lying above and spaced from a second guide plane as such is known in the art and taught by Flora. Such a modification to the apparatus of Gerhard will enable said apparatus to properly dispense and collate sheets as they are placed upon each other (see above cited text; also column 2, lines 7-54).

Gerhard is silent as to the specific folding and joining means. Neubauer discloses an apparatus as discussed above. The folding device 416 is capable of functioning as a

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folding and joining device. At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the apparatus of Gerhard as modified by Flora by adding a folding device capable of passing through the guide planes in order to fold the sheets as taught by Neubauer above as such a folding device enables the modified apparatus to produce a high quality fold. When the device 416 of Neubauer is added to the apparatus, said device must be capable of passing through the guide planes in order to fold the sheets of Gerhard.

As to claim 46, Flora discloses feeders (rollers 36, 38) arranged on opposite sides of guide planes so that the cover sheet and the contents sheet can be transported in opposite directions simultaneously (figure 6). As to claim 47, Flora discloses stops 190, 192 at the guide planes. While the use of the term "in particular" in the claim does not require that the stops be adjustable, stops 190 and 192 are adjustable.

4. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerhard, Flora and Neubauer, as applied to claim 41 above, and further in view of Graushar et al. (US 5662448).

Gerhard, Flora and Neubauer discloses the limitations of claim 41 as discussed above, but it is unclear if the reference discloses a device with monitoring devices for detecting deficient qualities in the vicinity of the folding device. Graushar discloses a device for joining a cover sheet to a contents sheet comprising a folding device capable of folding and joining the contents sheet to the cover sheet, said device further comprising monitoring devices for detecting deficient quality in the vicinity of a folding device (column 1, line 65 - column 2, line 11; column 3, lines 12-25). At the time the

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invention was made, it would have been obvious to one of ordinary skill in the art to modify the device of over Gerhard as modified by Flora and Neubauer by providing a monitoring device for detecting deficient quality in the vicinity of the folding device as taught by Graushar above as such a modification allows the device to produce a products with few defects.

5. Claims 49 and 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerhard, Flora and Neubauer as applied to claim 41 above, and further in view of Miaskoff et al. (US 3816866).

Gerhard, Flora and Neubauer discloses the limitation of claim 41 as discussed above, but it is unclear if the reference discloses a sorting device for removing defective cover and contents sheets from the vicinity of the folding device. Miaskoff discloses a device for monitoring the quality of a product comprising a cover sheet formed over a contents sheets, said device being capable of sorting out defective sheets and removing them (abstract). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the apparatus of over Gerhard, Flora and Neubauer by providing a sorting device capable of sorting out defective sheets and removing them as taught by Miaskoff above because such a modification increases the quality of the product produced by the device.

As to claim 50, Miaskoff discloses a good/bad detection device (abstract).



### ***Response to Arguments***

6. Applicant's arguments filed 07/08/2009 have been fully considered.

Applicant's arguments directed toward Honegger that may be applicable to the new grounds of rejection above will be addressed. The applicant attempts to distinguish sheets from webs. The use of the term "web" in applicant's claims does distinguish the apparatus from the prior art. The applicant argues that the sheets of Honegger are joined by pressing rolls and thus and a folding device does not function as a joining device because the sheets are joined before folding. First, the applicant should note that the folding device of Honegger's apparatus as modified by Gerhard is capable of functioning as a folding and joining device. It is noted that as long as the prior art device is *capable of performing the functional language* required by the claim, the claim is not distinguishable over the prior art. Additionally, while the sheets may contact each other before they are folded, they are not necessarily joined. The remainder of the applicant's arguments are moot in light of the new grounds of rejection presented above.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER SCHATZ whose telephone number is 571-272-6038. The examiner can normally be reached on Monday through Friday 9 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHRISTOPHER SCHATZ/  
Examiner, Art Unit 1791

/Richard Crispino/  
Supervisory Patent Examiner, Art Unit 1791